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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,240	08/24/2001	John W. Davies	38190/206669	2206

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EXAMINER

TORRES, MELANIE

ART UNIT

PAPER NUMBER

3683

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,240

Applicant(s)

DAVIES ET AL.

Examiner

Melanie Torres

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 3 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4 and 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman in view of Tohzuka.

Re claims 1 and 7, Speakman teaches a bearing assembly comprising a pair of bearing members (12, 32) movable relative to one another, the pair including a first member (12) and a second member (32) that define a space therebetween. (Column 1, lines 5-13, Figure 1) However, Speakman does not teach wherein at least the first member having a bearing surface having a relatively thin coating of a PTFE-based material thereupon and a grease lubricant occupying the space defined between the first member and the second member, wherein the PTFE-based material and the grease lubricant act in conjunction with one another to lubricate the first and second members. Tohzuka discloses a PTFE-based material in a grease medium wherein the PTFE-based material and the grease lubricant act in conjunction with one another. (Column 3, lines 1-7, Column 4, lines 22-34) It would have been obvious to have used the lubricant of Tohzuka in the assembly of Speakman so as to provide improved sliding surfaces between the two components. It is the examiner's position that, as claimed,

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the first member is readable as having a PTFE-based material and the grease material as is the second component although it is a mixed material in the lubricant of Tohzuka.

Re claims 2, 8 and 9, Speakman as modified teaches wherein the coating is a PTFE-based material having a solid particulate in a form selected from the group consisting of flocked, powdered, fibrous, flaked, or beaded. (Column 4, lines 22-34)

Re claims 4 and 11, Speakman teaches wherein the first member (12) is formed from the group consisting of steel, titanium, aluminum, nickel, bronze and alloys thereof. (Column 1, lines 5-7)

Re claim 6, Speakman teaches wherein the coating is a self-lubricating material.

3. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman in view of Tohzuka and further in view of Lee.

Re claims 5 and 12, Lee teaches sliding bearing comprising a seal (84) positioned in the space defined between first and second members. It would have been obvious to have included a seal in the assembly of Speakman as modified so as to reduce the amount of debris that would interfere with the operation of the bearing.

Response to Arguments

4. Applicant's arguments filed April 16, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicants argue, "the Examiner has made no showing of an actual teaching or suggestion to combine the references." The Examiner feels that the motivation used in the rejection above wherein "it would have been obvious to have combined the references so as to provide an improved sliding surface between the two components" is valid and would be well known in the art of bearings. Further, the Tohzuka et al. reference teaches in the cited sections (Column 3, lines 1-7) wherein this lubricant can be used in bearings for lubricity (in addition to noise). Therefore, the rejections above have been maintained.

Regarding applicants regarding claims 3 and 10, upon further consideration of applicants' disclosure the rejection has been withdrawn because the limitation is shown to solve a stated problem and is necessary for a particular purpose. (*In re Kuhle* 188 USPQ 7, CCPA 1975)

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Torres whose telephone number is (703)305-0293. The examiner can normally be reached on Monday-Friday, 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703)308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-2571 for regular communications and (703)308-2571 for After Final communications.

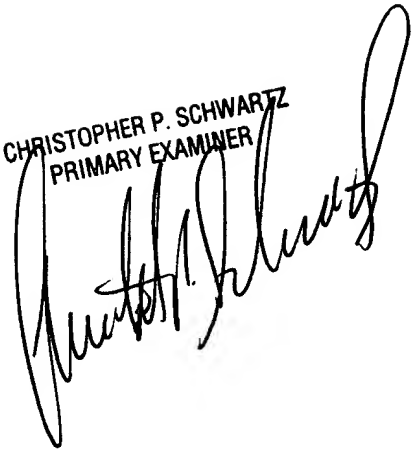
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

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MT
May 23, 2003

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Christopher P. Schwartz", written over the printed name and title.